

REMARKS

Claims 6, and 7 have been canceled. Claims 1, and 14 have been amended to limit the choice of possible surfactant to "phosphate-quaternary amine compounds". No new matter has been added and no additional claim fee is due. Claims 1-5, and 8-20 are pending in the application after the amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Rejections Under 35 USC §102

Claims 1, 4, 6, 10, 11, and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Coury et al., US Patent No 5,618,850. It is the Examiner's contention that Coury anticipates these claims. Applicants respectively traverse the rejection.

Section 2131 of the MPEP states to anticipate a claim, the reference "MUST TEACH EVERY ELEMENT OF THE CLAIM" (emphasis in original). Applicants respectfully submit that all the claim limitations are not taught or suggested by Coury, as shown below.

Applicants submit that Coury does not teach every element of Applicants' independent claims. In particular, Coury does not teach, disclose, or otherwise suggest a surfactant selected from the group consisting of a phosphate-quaternary amine compound. This claim element is expressly recited in Applicants' independent Claims 1 and 14. Therefore, unless and until the Examiner can identify in Coury any teaching of phosphate-quaternary amine compounds, Applicants respectfully submit that the Examiner's 35 U.S.C. §102(b) rejection should be withdrawn.

Rejections Under 35 USC §1031) Luu

Claims 1-16 have been rejected under 35 U.S.C. §103 as being obvious over Luu et al., US Patent No 5,871,763. It is the Examiner's contention that that the

claimed pre-moistened wipes are obvious in light of what is taught by Luu. Applicants respectively traverse the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP 706.02(j); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Said another way, the Examiner has failed to show any motivation, suggestion or teaching as to why one of ordinary skill would disregard the teaching in Luu and change from a substantially anhydrous lotion to an aqueous one. The Examiner is attempting to use the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Why would one of ordinary skill add water to the composition of Luu when the only teaching in Luu is of the problems associated with doing this?

As it was noted in Applicants' previous response, the Examiner has failed to establish a prima facie case of obviousness. Luu limits the amount of water, if any is present, in the lotion to "about 15% or less"; typically "with minor amounts of water" that is "present due to ambient humidity". See Column 3 line 66- Column 4 line 23. Luu provides teaching, suggesting and motivation to one of ordinary skill to use an anhydrous lotion with minimal water, if any, and instead teaches away from lotion containing a substantial amount of water. Contrast this teaching in Luu with

the position taken by the Examiner that a lotion containing "about 15% or less water" is equivalent to a lotion with a greater than 50% water content. The Examiner argues that the difference is insignificant and would be obvious to one of ordinary skill that would "by routine experimentation determine a suitable amount of water and suitable amount of antimicrobial agent".

With all respect to the Examiner, this is just plain wrong.

The question the Examiner has repeatedly failed to address is why would one of ordinary skill add water to the composition of Luu. Luu provides teaching of the problems associated with elevated water content. Column 4, lines 6 to 23. Luu teaches that a water free or low water content lotion provides improved storage and handling. Column 4, lines 6 to 9. Additionally, Luu teaches that increasing the amount of water increases the viscosity of the lotion. Column 4, lines 14 to 23. In other words there is no teaching, motivation or suggestion provided in Luu or by the Examiner as to why one of ordinary skill would add water to the composition of Luu. In effect, the Examiner is asking one of ordinary skill on the one hand to follow the teaching of some parts of Luu while on the other hand ignore other teaching of Luu, specifically that which teaches away from what the Examiner is asserting one of ordinary skill would do. The Examiner has failed to show any motivation, suggestion or teaching as to why one of ordinary skill would disregard the clear teaching in Luu regarding the desirability of anhydrous lotions and change from an oil based lotion to an aqueous one. In reality, Luu provides motivation, suggestion and teaching for one of ordinary skill of the exact opposite of what is being asserted by the Examiner, namely to exclude water entirely.

Finally, Applicants have limited the surfactant to those selected from the group consisting of a phosphate-quaternary amine compounds. Furthermore there is no teaching or suggestion in Luu of any synergy or advantage from the combination of a surfactant selected from the group consisting of a phosphate-quaternary amine compounds with either an alkoxylated alcohol or a non-cellulosic water soluble polymer in an aqueous lotion. There is simply no suggestion in Luu that would motivate one of ordinary skill to arrive at this novel and unobvious combination.

In light of the foregoing remarks, it is requested that rejection of Claims 1-16 be reconsidered and withdrawn.

2) Luu U.S. 5,781,763 in view of Blieszner

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being obvious over Luu et al., US Patent No 5,871,763 in view of Blieszner et al., US Patent No 5,648,083. It is the Examiners contention that that the claimed pre-moistened wipes are obvious in light of what is taught by Luu in view of Blieszner. Applicants respectively traverse the rejection.

Applicants are some what confused by this rejection. In the Examiners Office Action of October 1, 1999 the Examiner rejected Claims 1-9 under 35 U.S.C. §103(a) over the combination of Luu in view of Blieszner. The response March 29, 2000 by Mr. Roddy Bullock specifically addressed this rejection, giving reasons why Applicant's claims were not obvious in view of this combination. The subsequent Examiners Office Action of July 3, 2001, this rejection is not present in the Office Action, nor was it present in the Final Office Action of January 29, 2001. There is no notice of the rejection being withdrawn or any notice as to whether or not the Examiner has considered Mr. Bullock's arguments, however the subsequent Office Action did include the new rejection of the combination of Luu in view of Blieszner and Muckenfuhs.

It is also worth noting that there was a rejection of Claims 10-14 and 17-20 in view of Muckenfuhs in the Office Action of October 1, 1999. This rejection, like that of involving the combination of Luu in view of Blieszner, was not present in the July 3, 2001 Office Action, nor any subsequent Office Action for that matter. And also like the rejection over the combination of Luu in view of Blieszner there was no notice in the Office Action that this rejection was withdrawn. Like the combination of Luu in view of Blieszner rejection, the Examiner never mentioned the rejection of these claims over Muckenfuhs again.

This repeated omission of the rejections by the Examiner gave the Applicants reasonable grounds to believe that the arguments raised by Mr. Bullock's arguments were persuasive and led to the withdrawal of the rejections. Support for this

conclusion was the "new" rejection of Claims 1-20 by Luu in view of Blieszner and Muckenfuhs which was raised for the first time in the Office Action and was subsequent to Mr. Bullock's response of March 29, 2000. This new combination rejection gave Applicants reasonable ground to believe that the rejection of Claims 1-9 by Luu in view of Blieszner and the rejection of Claims 10-14 and 17-20 in favor of a rejection of Claims 1-20 by Luu in view of Blieszner and Muckenfuhs.

The Examiner can understand Applicants confusion that the Office Action of September 17, 2001 contains a rejection of Claims 8 and 9 by Luu in view of Blieszner. In view of this, Applicants fear that any subsequent Office Action will include rejections that Applicants had thought were previously dealt with, for example, a rejection under 102 over Muckenfuhs. It is the Applicants hope that this discrepancy is an isolated occurrence.

Consequently, according to the file history, the Examiner has not considered the original arguments made in response to the original rejection of Claims 8 and 9. Therefore, Applicants take this opportunity to reproduce them below for the Examiners further consideration and ultimate withdrawal of this rejection.

The Examiner rejected Claims 1-9 as being unpatentable over Luu, et al. (US 5,871,763) in view of Blieszner, et al. (US 5,648,083). The Examiner stated that Luu teaches a substrate treated with lotion in a wipe or nonwoven material. The Examiner stated that the lotion of Luu contains water, non-ionic surfactant, poloxamer, fragrance, and coco phosphatidyl PG-dimonium chloride of quaternary ammonium compounds. The Examiner stated that Luu does not specifically disclose the water soluble polymer and amount of water in the lotion. The Examiner stated that Blieszner teaches composition contains at least about 90% water by weight of the composition, and water soluble polymer is disclosed. The Examiner concludes that "it would have been prima facie obvious to one of the ordinary skill in the art to modify the method of Luu with the teaching of Blieszner to obtain the claimed invention because the skill artisan would have been motivated to by routine experimentation combine the well known ingredients and also determine a suitable amount of water to obtain the claimed invention."

Luu teaches an anhydrous lotion. That is, the lotion of Luu is preferably substantially free of water. (Col. 3, line 66.) Luu expressly discloses an advantage in formulating a water-free, or low water content lotion. (Col. 4 at lines 6 and 7). Blieszner, et al. teaches a silicon containing emulsion. (Col. 4 at lines 11-13).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. As discussed in detail below, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any of the rejected claims.

Applicants have claimed in each independent claim an aqueous solution. Applicants submit that there is no suggestion or motivation to combine the teachings of a patent disclosing a nonaqueous, anhydrous lotion, with a siliconized emulsion. Neither anhydrous lotion, nor a silicon containing emulsion, are an aqueous solution. Combining an anhydrous lotion and a siliconized emulsion would not produce an aqueous solution. Therefore, Applicants respectfully submit that there is no suggestion or motivation to combine the teachings of Luu, et al. with Blieszner, et al. to obtain Applicants' claimed invention. The Examiner has not stated where in Luu, et al. she finds a teaching of an aqueous solution. Neither has she show where in Blieszner, et al. there is a teaching of an aqueous solution.

Applicants further respectfully submit that there is no reasonable expectation of success that by combining the nonaqueous, anhydrous lotion of Luu, et al. with the siliconized emulsion of Blieszner, et al. that one would obtain the aqueous solution as claimed by Applicants. Therefore, unless and until the Examiner can articulate some reason why there would be such a reasonable expectation of success, Applicants respectfully submit that, at least for this reason, the Examiner has failed to establish a *prima facie* case of obviousness.

Finally, Applicants respectfully submit that the prior art references do not teach or suggest all the claim limitations. In particular, the prior art references do not teach or suggest an aqueous solution. Furthermore, the prior art references, either

individually or combined, do not teach or suggest the use of phosphate-quarternary amine compounds and non-ionic surfactants, and non-cellulosic organic water polymers and alkoxylated alcohols in an aqueous solution. Therefore, Applicants respectfully submit, that at least for this reason, the Examiner has failed to establish a prima facie case of obviousness.

Accordingly, for the reasons given above, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness under the standards set forth in MPEP Section 2141. Therefore, Applicants respectfully submit that the Examiner's 35 U.S.C. §103(a) rejections of Claims 1-9 should be withdrawn.

3) Luu U.S. 5,781,763 in view of Muckenfuhs

Claims 12-20 are rejected under 35 U.S.C. §103 as being obvious over Luu et al., US Patent No 5,871,763 in view of Muckenfuhs, US Patent No 5,332,118. It is the Examiners contention that that the claimed pre-moistened wipes are obvious in light of what is taught by Luu in view of Muckenfuhs. Applicants respectively traverse the rejection.

Applicants above have shown that Luu alone does not teach one of ordinary skill Applicants' present invention. Furthermore, the teaching pointed to specifically by the Examiner in Muckenfuhs does not provide any additionally teaching to overcome the fundamental difference between Applicants invention and Luu.

As was noted previously the surfactant for claims 12 to 16 has been limited to those selected from the group consisting of a phosphate-quaternary amine compounds. There is no teaching or suggestion in Luu of any synergy or advantage from the combination of a surfactant selected from the group consisting of a phosphate-quaternary amine compounds with either an alkoxylated alcohol or a non-cellulosic water soluble polymer in an aqueous lotion. There is simply no suggestion in Luu that would motivate one of ordinary skill to arrive at this novel and unobvious combination.

The teachings from Muckenfuhs provide no additional motivation or suggestion to one of ordinary skill to that of Luu. As the Examiner is well aware, any obviousness objections based on a combination of prior art references, such as in

the present situation, there must be some teaching, suggestion, or motivation to combine the references. See In re Rouffet 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir.1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). There is no such teaching, suggestion, or motivation to combine any of the references in the present situation. In Muckenfuhs there is no motivation, teaching, or suggesting that water or aqueous based lotion is any better than oil based lotion. As a matter of fact Muckenfuhs even teaches that a powder is on equal footing with any lotion. See Muckenfuhs column 10, lines 55-56. Muckenfuhs provides no motivation for one of ordinary skill to combine its teaching with that of Luu. There is no reason why one of ordinary skill would select the lotion of Luu out of the literally millions of possible lotions.

The Examiner is attempting to use the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q. 2d 1081 (Fed. Cir. 1986). The prior art references must provide some motivation for their selection by the artisan. Furthermore, there must always be a reasonable expectation of success to the selection and, no such reasonable expectation exists in the present situation. See In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In light of the amendments to the claims and the foregoing remarks, it is requested that rejection of Claims 12-20 be reconsidered and withdrawn.

CONCLUSION

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1-5, 8-20 are allowable over the prior art of record or

11

any combination thereof. In the event that issue remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned agent to discuss any remaining issues.

Respectfully submitted,

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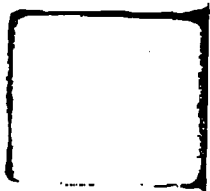
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VERSION WITH MARKINGS TO SHOW CHANGES MADEIn the claims:

1. (Amended) A lotion suitable for use in a disposable wiping article, the lotion being an aqueous solution comprising a surfactant selected from the group consisting of phosphate-quaternary amine compounds [and non-ionic surfactants], and effective amounts of a second ingredient selected from the group consisting of non-cellulosic organic water soluble polymers and alkoxylated alcohols.

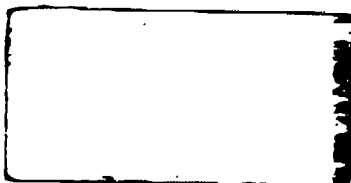
Please cancel Claims 6 and 7 without prejudice.

14. (Amended) A wiping article comprising a nonwoven substrate premoistened with a lotion, the lotion being an aqueous solution characterized by a surfactant selected from the group consisting of phosphate-quaternary amine compounds [and non-ionic surfactants,] and effective amounts of a second ingredient selected from the group consisting of non-cellulosic organic water soluble polymers and alkoxylated alcohols.



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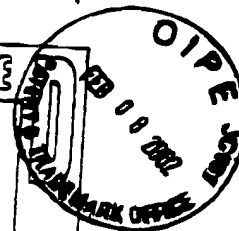
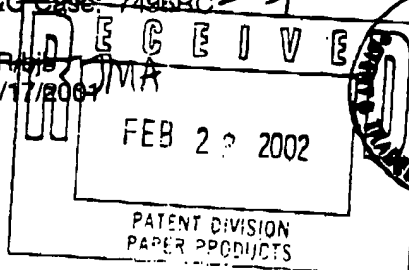
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